

REMARKS

In response to the Office Action of November 14, 2002, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. Amendments and/or cancellation of claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-37 are pending in this application. By this Amendment, Claims 1, 5, 6, 17, 21, 22, 30, 34 and 35 have been amended to further define the embodiments claimed herein. This Amendment has been formatted in accordance with the Pre-OG notice set forth in the U.S. Patent and Trademark Office's website (i.e., www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm). Applicants respectfully submit that no new matter has been added to this application nor have any new issues been raised by this amendment.

An indication by the Examiner that Claims 11-13, 15-16, 26, 28 and 29 contain allowable subject matter over the prior art of record is noted with appreciation.

The Examiner has rejected Claims 1-10, 14, 17-25, 27 and 30-37 under 35 U.S.C. §102(a) as being anticipated by Ahmed U.S. Patent No. 6,074,445 ("Ahmed"). Specifically, the Examiner alleges that Ahmed teaches a method for operating an engine, a method for reducing friction in an engine and a fuel composition comprising a hydrocarbon fuel containing preferably about 25 to about 40% by volume of a fuel grade alcohol, e.g., ethanol (see column 7, lines 42-47) and an additive comprising a Superamide of an alkyl ester of a fatty acid and an alcohol amine, and a higher alcohol and an ethoxylated fatty acid.

Amended independent Claims 1, 17 and 30 presently recite a "fuel composition comprising (a) a major amount of an internal combustion engine hydrocarbon fuel containing at least one alcohol, it being provided that methyl tertiary-butyl ether ("MTBE") is substantially absent from the fuel; and, a friction modifying amount of a friction modifier *consisting essentially of* a reaction product of at least one natural or synthetic oil and at least one alkanolamine."

In contrast thereto, Ahmed discloses a fuel composition containing (a) a hydrocarbon fuel containing from about 25 to about 40% by volume of ethanol and (b) a polymeric fuel additive comprising a Superamide of an alkyl ester of a fatty acid and an alcohol amine, and a higher ethoxylated alcohol and an ethoxylated fatty acid. It is well established that in a composition claim, the phrase "consisting essentially of" limits the scope of the claim to the specific ingredients and those that do not materially affect the basic and novel characteristic(s) of the composition". *Atlas Powder Co. v. I.E. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1573-74, 224 USPQ 409, 411 (Fed. Cir. 1984). To produce the polymeric fuel additive of Ahmed, the Superamide of an alkyl ester of a fatty acid and an alcohol amine must be combined with a higher ethoxylated alcohol and an ethoxylated fatty acid to ethoxylate the Superamide (see column 4, lines 11-23). Thus, the addition of the higher ethoxylated alcohol and an ethoxylated fatty acid to the Superamide unquestionably materially affects the basic and novel characteristics of Ahmed's polymeric fuel additives by *absolutely* requiring the inclusion of the material higher ethoxylated alcohol and an ethoxylated fatty acid to the Superamide to form the polymeric fuel additive and its subsequent use in the fuel composition. Applicants instead employ in their fuel composition a friction modifying amount of a friction modifier *consisting essentially of* a

reaction product of at least one natural or synthetic oil and at least one alkanolamine. Thus the addition of other components to the specifically recited reaction product would affect its utility as a friction modifier, i.e., the ethoxylated alcohol and the ethoxylated fatty acid of the Ahmed reference.

For the foregoing reasons, amended independent Claims 1, 17 and 30 which presently recite a "fuel composition comprising (a) a major amount of an internal combustion engine hydrocarbon fuel containing at least one alcohol, it being provided that methyl tertiary-butyl ether ("MTBE") is substantially absent from the fuel; and, (b) a friction modifying amount of a friction modifier consisting essentially of a reaction product of at least one natural or synthetic oil and at least one alkanolamine" are believed to be patentable over the subject matter of Ahmed.

Claims 2-10, 14, 18-25, 27 and 31-37 ultimately depend from amended independent Claims 1, 17 and 30 and therefore contain the same limitations as amended independent Claims 1, 17 and 30. Accordingly, for at least the same reasons given for amended independent Claims 1, 17 and 30, Claims 2-10, 14, 18-25, 27 and 31-37 are believed to be patentable over the subject matter of Ahmed. Thus, withdrawal of the rejection under 35 U.S.C. §102(a) and allowance of Claims 1-10, 14, 17-25, 27 and 30-37 is respectfully requested.

The Examiner has provisionally rejected Claims 1-37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-40 of co-pending Application No. 09/708,237. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

For the foregoing reasons, amended Claims 1-37 as presented herein are believed to be in condition for immediate allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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